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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KISS, ERIC B

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 11/20/2003 *7*

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/506,125

Applicant(s)

ANDREW ET AL.

Examiner

Eric B. Kiss

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The amendment of August 27, 2003, has been received and entered. Claims 26-46 are pending.

Response to Amendment

2. Applicant's amendment to the specification appropriately addresses the objection to the drawings, as detailed in the previous office action. Accordingly, this objection is withdrawn in view of Applicant's amendment.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 26-32, 34-36, and 38-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 26-32, the system recited in these claims is not tangibly embodied, i.e., there is no expressed structural and functional interrelationship between the environment of linked computers in the preamble of claim 26 and the computer software elements in the body of

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claims 26-32. Without such an expressed interrelationship, the functionality of the software components cannot be realized. Therefore, the claimed invention is descriptive material per se, and is not statutory because it is not a physical “thing” nor a statutory process, as there are not “acts” being performed. *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106(IV)(B)(1)(a).

As per claims 34-36, the system recited in these claims is not tangibly embodied, i.e., there is no expressed structural and functional interrelationship between any computer hardware and the computer software elements in the body of claims 34-36. Without such an expressed interrelationship, the functionality of the software components cannot be realized. Therefore, the claimed invention is descriptive material per se, and is not statutory because it is not a physical “thing” nor a statutory process, as there are not “acts” being performed. *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106(IV)(B)(1)(a).

As per claims 38-41, the claimed invention is not a computer-implemented method and, as claimed, cannot be limited to a practical application in the technological arts. See *Diamond v. Diehr*, 450 U.S. at 183-84, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1877)) (“A [statutory] process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.... The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of

secondary consequence.”). See also *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *id.* at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) (“unpatentability of the principle does not defeat patentability of its practical applications”) (citing *O ’Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). If a physical transformation occurs outside the computer, a disclosure that permits a skilled artisan to practice the claimed invention, i.e., to put it to a practical use, is sufficient. On the other hand, it is necessary for the claimed invention taken as a whole to produce a practical application if there is only a transformation of signals or data inside a computer or if a process merely manipulates concepts or converts one set of numbers into another.

5. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. §101 (nonstatutory) above are further rejected as set forth below in anticipation of Applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 112

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 42, it is unclear how the method of claim 38, in which steps are carried out by a first system user and a second system user, can be implemented through a set of computer-readable instructions. The specification appears to imply that the users are human beings, and while, for example, the execution environment inherently involves interaction with computer hardware /software, the human implemented method of claim 38 presumably cannot, per se, be tangibly embodied on a computer-medium as computer-executable instructions.

Claim Rejections - 35 USC § 102

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 26-37 and 43-46 are rejected under 35 U.S.C. 102(b) as being anticipated by the Adobe® FrameMaker®+SGML integrated XML authoring and composition tool as disclosed by “Adobe® FrameMaker®+SGML 5.5: Developing SGML Publishing Applications,” 1997 (hereinafter *AFM97*) and Charles F. Goldfarb and Paul Prescod, “The XML Handbook,” 1998 (hereinafter *Goldfarb and Prescod*), pp. 278-295.

As per claim 26, *Goldfarb and Prescod* disclose a set of one or more routines for producing an executable program component of the computer application software product (see,

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for example, section 21.2 and its corresponding subsections on pages 280-288); at least one resource file comprising a document in a markup language, wherein tagged text elements are associated with attributes of a user interface (Adobe® FrameMaker® is disclosed as a tool for creating and editing XML documents; see, for example, section 21.2 and its corresponding subsections on pages 280-288 of *Goldfarb and Prescod*); and a set of one or more routines for creating and modifying the user interface component by manipulating the at least one user interface resource file (see, for example, section 21.2 and its corresponding subsections on pages 280-288). *AFM97* discloses, as part of application development with the FrameMaker®+SGML tool, various skills required within the implementation team, including document design, SGML knowledge, setting up FrameMaker®_SGML formatting templates, and setting up the formatting rules that control automatic application of the desired graphic design to structure documents. Further *AFM97* discloses these skills as being shared by the group of people rather than being mastered by one individual.

As per claim 27, *Goldfarb and Prescod* further disclose the routines for creating and modifying the at least one user interface resource file being used while the computer program is being executed, the creating and modifying occurring dynamically and not requiring a recompilation of the executable program component (see, for example, section 21.3 and its corresponding subsections on pages 288-290; the product has a WYSIWYG environment).

As per claims 28 and 30-32, *Goldfarb and Prescod* further disclose a set of operating system resource-loading routines for presenting a user interface corresponding to the user interface component (see, for example, see, for example, section 21.2.1 on page 281). Further, as the FrameMaker®+SGML tool is a collaborative tool (see, for example, *Goldfarb and*

Prescod, section 21.4; and *AFM97*, "The implementation team" on pages 7-8), the generated user interface can be viewed by any member of the implementation team.

As per claim 29, *Goldfarb and Prescod* further disclose the resource-loading routines obtain user interface resource information from a user interface attribute data tree corresponding to the user interface resource file and, with respect to resource information not specified in the user interface resource file, from a set of default sources of user interface resource information (see, for example, section 21.2.1 on page 281; and section 21.2.5 on page 288).

As per claim 33, *Goldfarb and Prescod* further disclose a computer-readable medium storing computer-executable instructions and computer-readable data for implementing the aforementioned components (see, for example, page 278, indicating a free trial version of FrameMake®+SGML on CD-ROM).

As per claims 34 and 37, *Goldfarb and Prescod* disclose a set of one or more routines for modifying at least one user interface resource file (see, for example, section 21.2 and its corresponding subsections on pages 280-288); and the at least one resource file comprising a document in a markup language, wherein tagged text elements are associated with attributes of a user interface (Adobe® FrameMaker® is disclosed as a tool for creating and editing XML documents; see, for example, section 21.2 and its corresponding subsections on pages 280-288). *Goldfarb and Prescod* further disclose a computer-readable medium storing computer-executable instructions and computer-readable data for implementing the aforementioned components (see, for example, page 278, indicating a free trial version of FrameMake®+SGML on CD-ROM).

As per claim 35, *Goldfarb and Prescod* further disclose the routines for modifying the at least one user interface resource file being invoked while the computer program is being executed, the customizing occurring dynamically (see, for example, section 21.3 and its corresponding subsections on pages 288-290; the product has a WYSIWYG environment).

As per claim 36, *Goldfarb and Prescod* further disclose a set of operating system resource-loading routines for presenting the user interface to the user, wherein the resource-loading routines obtain user interface resource information from a user interface attribute data tree corresponding to the user interface resource file and, with respect to resource information not specified in the user interface resource file, from a set of default sources of user interface resource information (see, for example, section 21.2.1 on page 281; and section 21.2.5 on page 288).

As per claims 43 and 46, *Goldfarb and Prescod* disclose executing a computer program, thereby causing a user interface to be presented (see, for example, section 21.3 and its corresponding subsections on pages 288-290); editing at least one user interface resource file, the at least one user interface file comprising a document in a markup language, wherein tagged text elements are associated with attributes of the user interface (Adobe® FrameMaker® is disclosed as a tool for creating and editing XML documents; see, for example, section 21.2 and its corresponding subsections on pages 280-288); and causing a new user interface to be presented (see, for example, section 21.3 and its corresponding subsections on pages 288-290; the product has a WYSIWYG environment). *Goldfarb and Prescod* further discloses a computer-readable medium storing computer-executable instructions and computer-readable data for implementing

the aforementioned steps (see, for example, page 278, indicating a free trial version of FrameMake®+SGML on CD-ROM).

As per claim 44, *Goldfarb and Prescod* further discloses parsing the at least one user interface resource file into a user interface attribute data tree (see, for example, section 21.2.1 on page 281); invoking operating system resource-loading routines for constructing the user interface (see, for example, section 21.3 and its corresponding subsections on pages 288-290; the product has a WYSIWYG environment); and obtaining user interface resource information from the user interface attribute data tree, and with respect to resource information not specified in the user interface resource file, from a set of default sources of user interface resource information (see, for example, section 21.2.1 on page 281; and section 21.2.5 on page 288).

As per claim 45, *Goldfarb and Prescod* further discloses causing the user interface to be presented occurring while the computer program is being executed and not requiring the computer program to be re-executed (see, for example, section 21.3 and its corresponding subsections on pages 288-290; the product has a WYSIWYG environment).

Claim Rejections - 35 USC § 103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Adobe® FrameMaker®+SGML integrated XML authoring and composition tool as disclosed by

“Adobe® FrameMaker®+SGML 5.5: Developing SGML Publishing Applications,” 1997 (hereinafter *AFM97*) and Charles F. Goldfarb and Paul Prescod, “The XML Handbook,” 1998 (hereinafter *Goldfarb and Prescod*), pp. 278-295.

As per claim 38, *Goldfarb and Prescod* disclose causing a user interface to be presented while a computer program is being executed and not requiring the computer program to be re-executed (see, for example, section 21.3 and its corresponding subsections on pages 288-290; the product has a WYSIWYG environment). In the WYSIWYG environment of FrameMaker®+SGML, making changes to the user interface can be done without necessarily requiring a change in the executable code, such as disclosed in *Goldfarb and Prescod*, section 21.3.2. Further, the FrameMaker®+SGML tool is a collaborative tool (see, for example, *Goldfarb and Prescod*, section 21.4; and *AFM97*, “The implementation team” on pages 7-8). *AFM97* discloses, as part of application development with the FrameMaker®+SGML tool, various skills required within the implementation team, including document design, SGML knowledge, setting up FrameMaker®_SGML formatting templates, and setting up the formatting rules that control automatic application of the desired graphic design to structure documents. Further *AFM97* discloses these skills as being shared by the group of people rather than being mastered by one individual. FrameMaker®+SGML is not expressly disclosed as being used in a development environment comprising at least two users -- one developer and one graphic designer, where the graphic designer proposes necessary functional changes to the developer. However, it is well known and practiced in the software development art to split up the tasks of an overall software development project into subtasks relating to programming and graphical

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interface design. This common practice is also acknowledged by Applicant on page 3, lines 9-11 of the specification. Therefore, it would have been obvious to one having ordinary skill in the computer art at the time the invention was made to use the FrameMaker®+SGML tool in a development environment comprising at least two users -- one developer and one graphic designer, where the graphic designer proposes necessary functional changes to the developer. One would be motivated to do so to promote more cost effective and efficient software development.

As per claim 39, *Goldfarb and Prescod* further disclose at least one resource file comprising a document in a markup language, wherein tagged text elements are associated with attributes of a user interface Adobe® FrameMaker® is disclosed as a tool for creating and editing XML documents; see, for example, section 21.2 and its corresponding subsections on pages 280-288 of *Goldfarb and Prescod*). Therefore, for reasons applied above, such a claim also would have been obvious.

As per claim 40, *Goldfarb and Prescod* further disclose parsing the at least one user interface resource file into a user interface attribute data tree (see, for example, section 21.2.1 on page 281); and obtaining user interface resource information from the user interface attribute data tree, and with respect to resource information not specified in the user interface resource file, from a set of default sources of user interface resource information (see, for example, section 21.2.1 on page 281; and section 21.2.5 on page 288). Therefore, for reasons applied above, such a claim also would have been obvious.

As per claim 41, *Goldfarb and Prescod* further discloses causing the user interface to be presented occurring while the computer program is being executed and not requiring the

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computer program to be re-executed (see, for example, section 21.3 and its corresponding subsections on pages 288-290; the product has a WYSIWYG environment). Therefore, for reasons applied above, such a claim also would have been obvious.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 26-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of copending Application No. 09/452,421. Although the conflicting claims are not identical, they are not patentably distinct from each other as, for example, illustrated below:

Claim 20 of Application No. 09/452,421:

...a first group of workers for generating functional code for an application in course of developing the application...

Claim 26 of the instant application:

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...a first set of one or more routines used by a first system user for producing an executable program component of the computer application software product...

Here, the task of *generating functional code for an application* and *producing an executable program component* are not patentably distinct because both limitations recite the same functionality, i.e., creating a portion of an overall computer software application.

Claim 20 of Application No. 09/452,421:

...a second group of workers who modify the functional code by modifying an external resource data-containing file, wherein the external resource data-containing file includes markup language whereby obviating compilation of the external resource data-containing file for the execution of the functional code...

Claim 26 of the instant application:

...at least one user interface resource file comprising a document in a markup language, wherein tagged text elements are associated with attributes of a user interface component of the computer application software product; and a second set of one or more routines used by a second system user for creating and modifying the user interface component by manipulating the at least one user interface resource file, wherein the creating and modifying by the second system user is independent of actions taken by the first system user...

Here, the task of *modifying an external resource data-containing file, wherein the external resource data-containing file includes markup language* is functionally identical to *manipulating the at least one user interface resource file [comprising a document in a markup language...]*.

Claim 20 and dependent claim 21 of Application No. 09/452,421:

...a graphical control locator for locating the external resource data-containing file responsively to the functional code; and
an external resource data-containing file parser for identifying a requested parameter stored in the external resource data-containing file.
...wherein a resource loader provides both the services of the graphical control locator and the external resource file markup language parser.

Claims 28 and 29 of the instant application (depending from claims 26 and 28, respectively):

...a set of operating system resource-loading routines for presenting a user interface corresponding to the user interface component to a third system user...
...wherein the resource-loading routines obtain user interface resource information from a user interface attribute data tree corresponding to the user interface resource file and, with respect to resource information not specified in the user interface resource file, from a set of default sources of user interface resource information.

Here, although the instant application does not expressly claim the resource-loading routines comprising *a graphical control locator* and *an external resource data-containing file parser*, the specified tasks of *obtain[ing] user interface resource information from a user interface attribute data tree corresponding to the user interface resource file* implies that the user interface resource file is parsed and the resulting data is processed. Additionally, claim 21 of Application No. 09/452,421 suggests that the resource loader provides this requisite functionality.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric B. Kiss whose telephone number is (703) 305-7737. The Examiner can normally be reached on Tue. - Fri., 7:30 am - 5:00 pm. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam, can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

EBK
November 14, 2003



TUAN DAM
SUPERVISORY PATENT EXAMINER